REMARKS

Claims **36 - 48** were pending.

New claims **49 - 64** have been added.

Claims **36, 45, 48, 49 and 52** are independent.

Priority

The priority information on page 1 of the specification has been amended.

DOUBLE PATENTING

Claims **45 - 48** are rejected for obvious-type double patenting in light of U.S. Patent No. 6,688,976. The rejection fails to create a *prima facie* case of obviousness of any pending claim.

The only basis provided for the double patenting rejection is that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because both claim methods for facilitating a lottery ticket transaction ...".

In other words, the only basis for the rejection is that the pending claims and issued claims both include certain limitations. This is not the correct standard for determining whether pending claims are obvious in light of issued claims.

1. Applicable Law of Double Patenting

Any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. MPEP 804(II)(B)(1). Thus, the factual inquiries set forth in Graham v .John Deere that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. MPEP 804(II)(B)(1).

The factual inquiries that must be made are:

(A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.

See MPEP 804(II)(B)(1).

When considering whether a claim of an application is an obvious variation of a claim of a patent, the disclosure of the patent may not be used as prior art. MPEP 804(II)(B)(1).

2. One-way test was not applied

The '976 patent used in the double patenting rejection was not filed after the filing date of the present application. Therefore, the "one-way test" is required. MPEP 804(II)(B)(1)(a).

This test is a determinant of whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim in the patent. MPEP 804(II)(B)(1)(a).

However, the Examiner has not determined whether the pending claims are obvious variations of the issued claims. The Examiner has merely asserted that the pairs of claims include similar limitations. Therefore the Examiner has not created a *prima facie* showing of obvious-type double patenting.

3. Claim limitations ignored

In addition, in determining the obviousness of a claim, all claim limitations must be considered. The rejection ignores several claims limitations of the claims. Accordingly, a *prima facie* case has not been made.

4. No motivation to modify

No motivation to modify any of the patented claims is indicated. In any obviousness analysis there must be a specific teaching or suggestion in the prior art to combine or modify the reference claims.

Essentially, the only basis for the rejection is that the pending and issued claims include similar limitations. This falls far short of the required motivation to modify.

Section 102 Rejections

Claim **48** is rejected as anticipated by "New National Phone Service Helps Lotto Players Increase Their Chances of Winning", PR Newswire, January 17, 1990 ("Phone Service"). The rejection over the Phone Service article fails to create a *prima facie* case of either anticipation or obviousness of any pending claim.

The Examiner has misinterpreted much of the Phone Service article.

1. No suggestion of *receiving a request that the lottery number combination will be exclusively associated with only a single lottery ticket for the lottery drawing*

The Examiner contends that Phone Service discloses:

> "Player's requesting lottery number combinations that are exclusively associated with only a single lottery ticket for the lottery drawing"

[Office Action, page 4, first paragraph]

Simply put, the system described by Phone Service does not make any lottery number combination exclusively associated with only a single lottery ticket for a lottery drawing.

On the contrary, the Phone Service article discloses a computer operated 900 number telephone service that has nothing to do with associating lottery numbers with lottery tickets. The 900 number service allows a caller to be told "unique and non-duplicated lotto numbers" for the specific state lotto game they indicate. [Phone Service, third paragraph]

In other words, the 900 number service is a system a player would use to help choose their lottery numbers, much like players may let quick-pick random number generators select numbers, or the player may use his "lucky numbers". [Phone Service, fifth paragraph]

The 900 number service does not sell the player any ticket - it is a merely a phone service and could not actually provide the player with a ticket.

The 900 number service does not assure that any number will be "exclusively associated with only a single lottery ticket" as the Examiner contends. Instead, the 900 number service merely assures that all other players "**that use this service**" to pick their numbers will not be told the same numbers. [Phone Service, fourth paragraph] (emphasis added).

Therefore, many people could purchase tickets that all have the same lottery number combination. For example, a plurality of people who never use the 900 number service may all select the same lottery number combination and purchase tickets accordingly. Even people that use this service can pick other lottery number combinations that were not suggested by the service.

2. No suggestion of *determining the lottery number combination such that the lottery number combination is exclusively associated with only a single lottery ticket*

The Examiner contends that Phone Service discloses:

"The lottery number combinations are determined such that a lottery number combination is associated with only a single lottery ticket."

[Office Action, page 4, first paragraph]

As explained above, the system described by Phone Service does not associate any lottery number combination with only a single lottery ticket.

On the contrary, the Phone Service article discloses a computer operated 900 number telephone service that has nothing to do with associating lottery numbers with lottery tickets. The 900 number service allows a caller to be told "unique and non-duplicated lotto numbers" for the specific state lotto game they indicate. [Phone Service, third paragraph]

3. No suggestion of *preventing the lottery number combination from being associated with at least one additional lottery ticket*

The Examiner contends that Phone Service discloses:

"Therefore, the lottery number combination is prevented from being associated with at least one additional lottery ticket."

[Office Action, page 4, first paragraph]

As explained above, the system described by Phone Service does not associate any lottery number combination with only a single lottery ticket.

The 900 number service could not direct "every major lotto game in America" to prevent the lottery number combination from being associated with at least one additional lottery ticket in that lotto game.

Section 103 Rejections

Claims **36 - 40, 43 and 44** are rejected over a combination of Scanlon (U.S. Patent No. 4,922,522) and Double Lotto. Claims **41 and 42** are rejected over a combination of Scanlon, Double Lotto and "Our Opinion State Scamming Lottery Buyers".

The rejection fails to demonstrate a *prima facie* case of obviousness of any pending claim.

All of the claims rejected for obviousness include a limitation in which the price associated with a lottery ticket for a pari-mutuel lottery game is determined:

> *based on an expected value to a player of the lottery ticket having the lottery number combination*

No reference suggests such a limitation.

As best as we understand the rejection, the Examiner asserts that Double Lotto suggests this type of determination. However, Double Lotto only has two prices: $2 or $1. [Double Lotto, second paragraph] Any "determination" that Double Lotto may be said to disclose is based solely on whether a ticket has two plays or one play. [Double Lotto, second paragraph] Whether the price is $2 or $1, that price is not *based on an expected value to a player of the lottery ticket having the lottery number combination*.

The Examiner agrees with us that Double Lotto is "a pari-mutuel lottery game". [Office Action, page 5, second paragraph] A "pari-mutuel" lottery game is a game:

"in which those who bet on the winner share the total stakes minus a small percent for the management

Webster's Third New International Dictionary, Unabridged. Merriam-Webster, 2002. http://unabridged.merriam-webster.com

Copies of the definition of "pari-mutuel" from both the *Webster's Third New International Dictionary, Unabridged* and *The American Heritage® Dictionary of the English Language, Fourth Edition* are included with this Response.

Therefore, in such a game, all winners (i.e. all players whose lottery tickets have the same winning *lottery number combination*) divide the winnings. If there are more of these players holding the same *lottery number combination*, each player would win less than if there were fewer such players.

This is also clearly explained in the present application, for example, at page 2, lines 25 - 29:

"A first lottery ticket associated with a lottery number combination that is not associated with any other lottery ticket has a higher expected value to a player than a second lottery ticket associated with a lottery number combination that is also associated with one or more other lottery tickets. As a result, players may be willing to pay a higher price for the first lottery ticket."

Consequently, in such a game, the *expected value to a player of the lottery ticket having the lottery number combination* is necessarily based on whether there are other lottery tickets having the *same lottery number combination*. Double Lotto does not disclose taking such information into consideration at all.

In fact, no reference cited by the Examiner suggests the limitation in question.

TERMINAL DISCLAIMER

A terminal disclaimer over commonly-owned U.S. Patent No. 6,688,976 was filed on September 24, 2004. The Examiner asserts that the terminal disclaimer was not accepted because it did not comport with all of the requirements for a terminal disclaimer under 37 C.F.R. § 1.321(c).

However, the terminal disclaimer was intentionally and clearly filed under 37 C.F.R. § 1.321**(b)**, not 1.321**(c)**. The correspondence with which the terminal disclaimer was filed correctly identified our intent to file the terminal disclaimer under 37 C.F.R. 1.321(b). Further, the terminal disclaimer satisfies all requirements of 37 C.F.R. §1.321(b). Therefore, the terminal disclaimer must be recorded as such.

Rule 1.321(b)

The terminal disclaimer was in fact filed under 37 C.F.R. § 1.321(b), not 1.321(c), and fully complies with all of the requirements of § 1.321(b).

The top of the terminal disclaimer is clearly labeled "**Terminal Disclaimer Under 37 CFR 1.321(b)**".

We ask that the Examiner confirm in the record that the terminal disclaimer meets all the requirements of 37 C.F.R. § 1.321(b):

1.321(b)(1): The terminal disclaimer was signed by an attorney of record.

1.321(b)(2): The terminal disclaimer specified the portion of the term of the patent being disclaimed.

1.321(b)(3): The terminal disclaimer stated the present extent of applicant's or assignee's ownership interest in the patent to be granted.

1.321(b)(4): The terminal disclaimer was accompanied by the fee set forth in 37 C.F.R. § 1.20(d).

Rule 1.321(c) Not Applicable

When this terminal disclaimer was filed, no double patenting rejection had ever been imposed in the present application. Consequently, the requirements specified in 37 C.F.R. § 1.321(c) are not applicable. Rule 321(c) applies **only** to a terminal disclaimer that is "filed to obviate a judicially created double patenting rejection in a patent application". This terminal disclaimer was not "filed to obviate a judicially created double patenting rejection", and therefore the Rule 321(c) by its own terms does not apply.

The fact that the Examiner, after the filing of the terminal disclaimer, has asserted or attempted to assert a double patenting rejection is irrelevant to the acceptability of the terminal disclaimer that had been filed under 37 C.F.R . § 1.321(b).

Incidentally, as argued above, the Examiner has still failed to raise any *prima facie* case of double patenting, so the terminal disclaimer is even now unnecessary to obviate any double patenting rejection. We have not filed the terminal disclaimer to obviate any double patenting rejection.

No Authority to Reject the Terminal Disclaimer

Since Rule 1.321(c) is not applicable, and since the terminal disclaimer complies with all requirements of Rule 1.321(b), there is no authority to reject the terminal disclaimer. In other words, there is no authority to prevent Applicants from submitting a terminal disclaimer pursuant to Rule 1.321(b).

According to the procedure specified MPEP 1490, pages 1400-91 to 1400-92 (8th edition, rev. 2), we assume the erroneous determination that the terminal disclaimer fails to satisfy with 37 C.F.R. § 1.321 was made by the paralegal of the Office of the Special Program Examiner of Technology Center 3700.

That portion of the MPEP specifies the procedure that the paralegal of the Office of the Special Program Examiner must follow in response to our filed terminal disclaimer:

> "TERMINAL DISCLAIMER IN PENDING APPLICATION PRACTICE >IN THE TECHNOLOGY CENTERS<
>
> Where a terminal disclaimer is filed in an application pending in a TC, it will be processed by the paralegal of the Office of the Special Program Examiner of the TC having responsibility for the application. The paralegal will:
>
> (A) Determine compliance with 35 U.S.C. 253 and 37 CFR 1.321 and 3.73, and ensure that the appropriate terminal disclaimer fee set forth in 37 CFR 1.20(d) >is/<was applied **;
> (B) Notify the examiner having charge of the application whether the terminal disclaimer is acceptable or not
> ...
> "

See, MPEP 1490, page 1400-91 (8th edition, rev. 2)

Thus, the paralegal must determine that the terminal disclaimer we filed

(1) complied with 35 U.S.C. § 253 (it satisfies the last paragraph of § 253)

(2) complied with 37 CFR 1.321 (it satisfies 1.321(b))

(3) included the fee in 37 CFR 1.20(d) ($55 was authorized and was charged on September 28, 2004)

Accordingly, the paralegal of the Office of the Special Program Examiner has **erroneously determined that the terminal disclaimer fails to satisfy 37 C.F.R. § 1.321, when it in fact complies with 37 C.F.R. § 1.321(b).**

We request that the Examiner correct the error in the record, and indicate recordation of the terminal disclaimer.

New Claims

New claims **49 - 64** have been added, including new independent claims **49 and 52**. The new claims distinguish over the references of record, either alone or in combination, and are patentable.

For example, independent claim **49** recites

determining a price associated with a lottery ticket having a lottery number combination based on a number of occurrences that are associated with the lottery number combination.

No reference of record suggests any sort of determination of any price *based on a number of occurrences that are associated with the lottery number combination.*

Independent claim **52** recites

receiving, from the lottery terminal, an indication that a set of symbols is to be associated with no more than a predetermined number of occurrences with respect to the drawing

No reference of record suggests that *a set of symbols is to be associated with no more than a predetermined number of occurrences.*

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Respectfully submitted,

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Date

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